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REMARKS

Applicant appreciates the attention of the Examiner to the application. The Office Action of the Examiner of January 12, 2005 has been reviewed with care in the preparation of this response. The amendment above and the following remarks are believed to be fully responsive to this action.

Status of Claims

Claims 1-51, as presented by the above amendment, are pending. The pending claims set forth a novel and non-obvious aerial work apparatus. Claims 3, 5, 15-19, 25, 26, 32-35, 39, 40 and 45-47 have been previously withdrawn from consideration in response to an election of species requirement. Allowance of all pending claims is respectfully requested in view of the above amendment and the following remarks.

Claims 1, 4 and 20 were rejected under 35 U.S.C. §102(b) as being anticipated by Inokuchi et al. (U.S. Patent No. 6,325,749). Claims 41 and 42 were rejected under 35 U.S.C. §102(b) as being anticipated by Woodling (U.S. Patent No. 5,727,645). Claims 2, 21 and 36 were rejected under 35 U.S.C. §103(a) as being unpatentable over Inokuchi et al. Claims 22-24, 37 and 38 were rejected under 35 U.S.C. §103(a) as being unpatentable over Inokuchi et al. as applied to claim 21 and further in view of Peterson et al. (U.S. Patent No. 5,431,526). Claims 6-8 were rejected under 35 U.S.C. §103(a) as being unpatentable over Woodling in view of Shammout (U.S. Patent No. 5,116,189). Claims 9, 28-30 and 44 were rejected under 35 U.S.C. §103(a) as being unpatentable over Woodling in view of Inokuchi et al. as applied to claim 2. Claims 10-13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Woodling in view of Inokuchi et al. as applied to claim 2 and further in view of Peterson et al. Claim 27 was rejected under 35 U.S.C. §103(a) as being unpatentable over Inokuchi et al. in view of Shammout. Claims 14 and 31 were rejected as being unpatentable over Woodling in view of Inokuchi et al. and further in view of Shammout. Claim 23 was rejected under 35 U.S.C. §112 ¶

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2 as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention.

Applicant has prepared and hereby submits the above amendment to the claims. Claims 6, 8, 14, 20, 23, 27, 28, 31, 41 and 43 have been amended. Claims 48-51 have been added. The amendment is fully supported by the specification to the application and does not include any new matter. The claims as amended, including new claims 48-51, are patentably distinguishable over the prior art and the references cited by the Examiner in particular.

Applicant now turns to the particular points raised by the Examiner in the Office Action of January 12, 2005.

Rejection of Claim 23 under 35 U.S.C. §112, ¶ 2

Claim 23 was rejected under 35 U.S.C. §112, ¶ 2 as failing to particularly point out the antecedent basis for the phrase "the rail support." Claim 23, as amended, is now dependent to claim 28, thereby providing the necessary antecedent basis. This correction addresses the lack of clarity in the claim as previously presented. Applicant asks therefore that the rejection of claim 23 on the basis of 35 U.S.C. §112, ¶ 2 be withdrawn.

Rejection of Claim 1 under 35 U.S.C. §102(b)

Claim 1 was rejected under 35 U.S.C. §102(b) as being anticipated by Inokuchi. Pending claims 2-19 are dependent to claim 1. Applicant respectfully traverses the rejection of claim 1 and any claim dependent to it and requests that each of these rejections be withdrawn.

Inokuchi does not disclose an aerial work apparatus having a platform control module mounted with respect to an aerial work platform attached to a boom where the module controls the position of the platform and the movement of the chassis on which the boom is mounted. The Examiner in the Office Action makes reference to FIGS. 4 and 11 in Inokuchi in support of his rejection. Only FIG. 11 shows an aerial work platform but the drawing provides no teaching of a platform control module. Although an operator is seen on the platform with his hand over a joy-stick device, there is no disclosure in Inokuchi as to its purpose or operation. Quite to the

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contrary to the inference suggested by the Examiner, the only discussion in the reference is with regard to a similar operation panel 57 in FIG. 7 which is associated only with the working of the two arm manipulators 59, 60 shown. (Inokuchi at col. 1, lines 12-18, 42-58). Anticipation requires that the identical invention to that contained in a claim be described in a single prior art reference. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 9 USPO 2d 1913 (Fed. Cir. 1989).

Since all of the limitations of claim 1 are not found in Inokuchi, Applicant believes that the rejection of claim 1 as being anticipated by Inokuchi should be withdrawn and that claim 1 and each claim dependent to it be allowed.

Rejection of Claim 20 under 35 U.S.C. §102(b)

Claim 20 was also rejected under 35 U.S.C. §102(b) as being anticipated by Inokuchi. Pending claims 21-35 are dependent to amended claim 20. Claim 20, as amended, is directed to an aerial work apparatus having a platform control module mounted with respect to an aerial work platform, the module being adapted to control the position of the platform. For the same reasons as stated above, no such module is disclosed by Inokuchi. Since all of the limitations of amended claim 20 are similarly not found in Inokuchi, Applicant believes that the rejection of claim 20, as amended, should be withdrawn and that amended claim 20 and each claim dependent to it be allowed.

Rejection of Claim 41 under 35 U.S.C. §102(b)

Claim 41 was rejected under 35 U.S.C. §102(b) as being anticipated by Woodling. Pending claims 42-47 are dependent to amended claim 41. Claim 41, as amended, is directed to an aerial work apparatus having a rail support frame with at least one substantially horizontal rail extending from a first end to a second end of the frame and having a work basket that is removably mounted to the frame and supported upon the rail.

Woodling discloses only a triangular-shaped connector 84 with two diagonally diverging connector elements 86, 88 that are adapted to be received by diagonally diverging connector brackets 96, 98 on personnel basket 72. When basket 72 is mounted upon connector 84,

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connector brackets 86, 88 engage and are supported by connector elements 96, 98. (Woodling at col. 3, line 30 to col. 4, line 55).

Woodling does not show nor disclose a rail support frame having at least one substantially horizontal rail that extends from a first end of the frame to a second end. The reference furthermore does not disclose a work basket that both mounts to the frame and is supported upon this horizontal rail. As a consequence, unlike Applicant's claimed invention, the personnel basket in Woodling must be elevated to a height above the connector for it to be mounted onto the connector. In addition, a far more complex structure 94 is required to be secured to the back of the basket in Woodling to enable the basket to be engaged to the connector.

Since Woodling lacks all of the limitations of amended claim 41, Applicant submits that the rejection of claim 41, as amended, should be withdrawn and that amended claim 41 and each claim dependent to it are now in position for allowance.

Rejection of Claims 2, 21 and 36 under 35 U.S.C. §103(a)

Claims 2, 21 and 36 were rejected under 35 U.S.C. §103(a) as being unpatentable over Inokuchi. The Examiner states that it would have been obvious to one of ordinary skill in the art to duplicate the teaching of a single winch device 10 in Inokuchi by providing a second winch device to enable dual lifting.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Jones, 958 F.2d 347 (Fed. Cir. 1992). In particular, there must be more of a justification for combining references or modifying them than solely the fact that such pieces of prior art happened to have been known at the time of the invention. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination or modification. MPEP §2143.01.

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A specific explanation why a skilled artisan would have been motivated to make a claimed modification must be set forth by an examiner after any rejection under 35 U.S.C. §103. MPEP §706.02(j). There is no showing in the present Office Action, however, of any reasons or motivation within Inokuchi to support the modification the Examiner relies upon for his rejection of claims 2, 21 and 36. The Examiner simply calls upon the supposed level of skill of one skilled in the art to provide the necessary motivation for the selection and modification of Inokuchi. This is not the showing required under the MPEP but rather an exercise in hindsight frowned upon by the courts. Moreover, the Examiner fails to even explain what the specific understanding or technological principle within the knowledge of a skilled artisan is that would have suggested to such an individual to make the very modification to the bucket in Inokuchi needed to arrive at the claimed aerial work platform.

In addition, Inokuchi teaches against modifying the bucket in the manner suggested. To do so would create a bucket that would lose its ability to work on hot-lines in a compact and lightweight manner. (Inokuchi at col.1, lines 19-42 and at col. 3, lines 58-65). Highly accurate positioning and working of a heavy object suspended from the suspender arm 10 is achieved with both of the two-armed manipulators 5, 6 that are already mounted on the bucket. Moreover, the limited space on the bucket is already compromised by the presence of a number of other pieces of equipment that include an automatic tool changer 8 and automatic material exchanger 9. (Inokuchi at col.8, line 56 to col. 9, line 5). Nowhere in Inokuchi is there a teaching that adding another suspender arm is, in any way, needed or desirable. The modification proposed by the Examiner would make the apparatus in Inokuchi highly unsatisfactory for its obviously intended purposes.

The lack of any explanation by the Examiner of the motivation for one skilled in the art to select and then modify the reference cited, along with the other reasons discussed above, establishes that a prima facie case of obviousness has not been made to maintain rejection of claims 2, 21 and 36. Applicant believes that this rejection should be withdrawn and that these claims, in addition to claims 22, 24, and 37-40 that are dependent to them, be allowed.

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Rejection of Claims 6-8 under 35 U.S.C. §103(a)

Claims 6-8 were rejected under 35 U.S.C. §103(a) as being unpatentable over Woodling in view of Shammout. As amended, these claims are not rendered obvious by these references but are instead patentably distinguishable over such prior art.

Any combination or modification of the prior art to establish obviousness must teach or suggest each and every one of the limitations set forth in the claim being rejected. MPEP §2143.03. For the reasons stated above with respect to the allowance of amended claim 41, Woodling does not show a rail support frame having at least one substantially horizontal rail extending from a first end to a second end and furthermore does not disclose a work basket that both mounts to the frame and is supported upon the horizontal rail as set forth in amended claim 6. These claim elements are furthermore not provided by Shammout. Since the combination of Woodling and Shammout lacks each of the limitations of amended claim 6, Applicant asks that the rejection of claim 6, as amended, be withdrawn and that amended claim 6 and claims 7-19 that are dependent to it be allowed.

Claim 8, as amended, adds the limitation that the material-handling device is at least two material support feet slidably attached to the front basket such that the feet are free to extend outward in front of the basket. This limitation is not taught by either Woodling or Shammout. The guide bars 34, 36 and guide slots 38, 40 in Shammout are referred to by the Examiner as disclosing material support feet. These structures are, however, secured to platform 18 for raising and lowering the platform beneath lift bucket 12. (Shammout at col. 4, lines 10-59). These "material support feet" therefore do not extend outward in front of the lift bucket. For these additional reasons, Applicant requests that the specific rejection of amended claim 8 be withdrawn.

Rejection of Claims 9, 28-30, and 44 under 35 U.S.C. §103(a)

Claims 9, 28-30, and 44 were rejected under 35 U.S.C. §103(a) as being unpatentable over Woodling in view of Inokuchi as modified. There are limitations, however, in each of these

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claims that are not shown by either of these references. Applicant respectfully traverses the rejection of these claims and asks that it be withdrawn.

Claim 9 requires a platform control module for controlling the position of the platform and movement of the chassis as well as a dual winch device. This feature is not disclosed by Woodling or Inokuchi. For reasons stated earlier, there is also no showing in the Office Action of a motivation to modify the apparatus in Inokuchi to include first and second winch assemblies.

Claim 28, as amended, requires a platform control module for controlling the position of the platform. It also includes the limitation that the rail support frame have at least one substantially horizontal rail and that the work basket be supported upon this rail. As explained above with respect to amended claim 20 and amended claim 6, both references fail to disclose each of these elements. Claim 30 adds the limitation of a dual winch device for which there is also no teaching or suggestion in either reference.

Claim 44 also requires the rail support frame have at least one substantially horizontal rail, the work basket be supported upon the rail, and the apparatus include a dual winch device. For each of the reasons set forth with respect to the allowance of amended claim 41 and claim 2 as well as elsewhere above, both Woodling and Inokuchi fail to teach or suggest either of these limitations.

Applicant believes that the rejection of claims 9, 28-30, and 44 has been traversed and that these claims as well as claims 10-14 that are dependent to claim 9 and claims 23 and 29-35 that depend from claim 28 be allowed.

Rejection of Claims 12 and 23 under 35 U.S.C. §103(a)

Claim 12 was rejected under 35 U.S.C. §103(a) as being unpatentable over Woodling in view of Inokuchi as modified and further in view of Peterson. Claim 23 was rejected under 35 U.S.C. §103(a) as being unpatentable over Inokuchi as modified and further in view of Peterson. Each claim is allowable at least by virtue of its dependency from a claim traversing any rejection by the Examiner as set forth above. In addition, however, both claims include a limitation that

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the first and second winch assemblies be mounted at opposite ends of the rail support frame. This feature is neither taught nor suggested by any of the references cited.

The Examiner acknowledges the absence of any teaching of the limitation in question by stating that attaching winch assemblies on opposite sides of a platform to provide balancing of the platform would be an obvious engineering expediency. There is no showing, however, in the present Office Action of any reasons or motivation within Woodling or Inokuchi or Peterson to support the combination and modification relied upon by the Examiner for the rejection of claims 12 and 23. For the Examiner to simply call upon the subjective basis of engineering expediency to provide the necessary motivation for the selection and modification of the references he relies upon is once again not the specific and objective explanation required to be set forth under MPEP §706.02(j) but rather an exercise in hindsight.

An examiner may not simply select from the prior art the separate components of the claimed invention through the use of the blueprint supplied by the inventor. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). The act of identifying the various elements of the claimed invention in the prior art without there being any teaching, suggestion or motivation for their combination is not the legal test of obviousness. It is, after all, well recognized that most, if not all, inventions are no more than combinations of old elements in the prior art. Environmental Designs, Ltd. V. Union Oil Co., 713 F. 2d 693, 218 USPQ 865 (Fed. Cir. 1983); Richdel, Inc. V. Sunspool Corp., 714 F. 2d 1573, 219 USPQ 8 (Fed. Cir. 1983). "If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.' Sensonics, Inc. v. Aerosonic Corp., 81 F. 3d 1566, 1570, 38 USPQ 2d 1551, 1554 (Fed. Cir. 1996)." In re Rouffet, 47 USPQ 2d at 1457 (Fed. Cir. 1998).

Moreover, there is an absence of any motivation in Woodling to modify its personnel basket or in Inokuchi to modify its bucket in the manner suggested by the Examiner. Woodling

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teaches an aerial lift with a removable basket already having a winch device as shown by winch cable 26 extending over sheave 34. There is no suggestion in Woodling as would motivate one skilled in the art to make superfluous the existing winch by the addition of two more winch assemblies. In addition, the supposed "rail support frame" in Woodling, a simple triangular-shaped piece 84 at the upper end of the boom 18, is entirely inadequate to support a dual winch device. Even if this structure could be fitted with two winch assemblies, it would defeat its intended purpose since the basket would no longer be able to be mounted over it.

Likewise, as explained above with respect to the allowance of claim 2, the proposed modification of Inokuchi would create a bucket that has lost its ability to work on hot-lines in a compact and lightweight manner. The combination and changes suggested by the Examiner would make the apparatus in Inokuchi highly unsatisfactory for its intended purposes.

For each of these specific reasons, Applicant asks that claims 12 and 23, as well as any claims that depend from them, be allowed.

Rejection of Claims 14, 27 and 31 under 35 U.S.C. §103(a)

Claim 27 was rejected under 35 U.S.C. §103(a) as being unpatentable over Inokuchi in view of Shammout. Claims 14 and 31 were rejected under 35 U.S.C. §103(a) as being unpatentable over Woodling in view of Inokuchi and further in view of Shammout.

Each claim is allowable at least by virtue of its dependency from a claim overcoming any rejection by the Examiner. In addition, however, each claim, as amended, includes the limitation that there are at least two material support feet slidably attached to the platform (amended claim 27) or front basket (amended claims 14 and 31) such that the feet are free to extend outward in front of the platform or basket respectively. This limitation is not taught by Inokuchi, Woodling or Shammout. As stated with respect to the allowance of amended claim 8, the supposed "material support feet" disclosed in Shammout are secured to a platform for raising and lowering this platform beneath the device's lift bucket. Since these structures do not extend outward in front of the lift bucket, Applicant requests that the specific rejections of amended claims 14, 27 and 31 also be withdrawn and these claims and any claims that depend from them be allowed.

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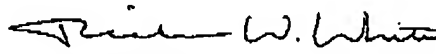
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Conclusion

Applicant's invention, as set forth in the amended claims, represents a novel and non-obvious aerial work apparatus. Applicant believes that the now pending claims 1-51 have elements not disclosed or suggested in the prior art. Applicant respectfully submits that all rejections in the Office Action have been traversed by amendment and argument, placing the application in condition for allowance. In addition, newly added claims 48-51 are patentably distinguishable over the prior art cited and Inokuchi in particular because the each of the applied references fail to teach or suggest "a platform control module mounted with respect to the platform for controlling the position of the platform and movement of the chassis" as set forth in independent claim 48.

Early favorable action is earnestly solicited. The Examiner is invited to call the undersigned if such would be helpful in resolving any issue which might remain. Please debit Deposit Account 10-0270 for a one-month extension fee. If any additional fees are due please debit Deposit Account 10-0270 and inform the undersigned.

Respectfully submitted,


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